

## **REMARKS/ARGUMENTS**

### **I. INTRODUCTION**

On August 13, 2009, the Board of Appeals and Interferences (“Board”) heard Applicant’s appeal regarding the rejections advanced by the Examiner against pending claims 14-19 and 27/14 of the present application. These rejections were the following:

- A. Claims 14-19, 24/14, and 27/14 under 35 U.S.C. §112, second ¶, for indefiniteness;
- B. Claims 14-17, 19/17, 24/14, and 27/14 under 35 U.S.C. §102(b) for anticipation based on Van Arsdel;
- C. Claims 14-17, 19/17, 24/14, and 27/14 under 35 U.S.C. §102(b) for anticipation based on Anson; and
- D. Claims 14, 18, and 19/18 under 35 U.S.C. §102(b) for anticipation based on Laubach.

In the Decision on Appeal (Attachment 1) dated August 31, 2009, the Board reversed the indefiniteness rejection, and the anticipation rejections based on Van Arsdale and Laubach. However, the Board affirmed the anticipation rejection based on Anson. The Board also noted in the Decision on Appeal that Applicant did not raise as an issue on appeal the Examiner’s provisional rejection under the judicially created doctrine of obviousness-type double patenting based on claims 20-28 of co-pending Application Ser. No. 10/720,821.<sup>1</sup>

During the Applicant’s argument, the Board raised that the “second section” of the Applicant’s invention was a “resting support” and the Anson attachment was not resting support but this had not been raised the prosecution. Applicant understood this to be a distinguishing feature between the claims of the present application and Anson.

Applicant will demonstrate herein that the claims, as amended, are patentable over Anson. Further, as Applicant indicated in the Appeal Brief at page 3, Applicant will file a terminal disclaimer to overcome the obviousness-type double patenting rejection upon the Examiner’s allowance of the claims.

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<sup>1</sup> The Board also heard Applicant’s appeal related to US Patent Application Serial No. 10/720,821 at the August 13, 2009 hearing because of its related issues on appeal.

## II. CLAIMS 14-19, 24/14, and 27/14 ARE NOT ANTICIPATED BY ANSON

The Examiner has rejected claims 14-19, 24/14, and 27/14, under 35 U.S.C. §102(b) for allegedly being anticipated by Anson. The description of the Anson attachment on which the Examiner relies in rejecting the pending claims for anticipation is the following:

I [Anson] have found that in the driving of an automobile and particular when driving for extended periods of time over long distances, the normal manner of holding and manipulating the steering wheel, wherein both driver's hands grasp the wheel and positions which require the driver's arms remain in a raised and more or less unnatural and uncomfortable position, considerable strain develops in the driver's hands, arms, shoulders and back particularly, and results in excess of fatigue...

To obviate these disadvantages, I have devised an attachment for steering wheel, which permits a driver to assume a completely comfortable and relaxed driving position, while at the same time, affords a means permitting the driver to at all times retain positive operating control of the steering wheel. [Emphasis added]  
Anson, Page 1, Left Column, Lines 6-25.

The steering wheel attachment of Anson is described as follows:

The attachment comprises a hand grip portion 11, which is preferably of bulbular form.... Grip portion 11 normally extends downwardly from the wheel rim and is of suitable length to adapt same to extend to the region of the driver's lap so that it may be grasped by the driver's hand when his hand is resting in a normal comfortable position in his lap. Grip portion 11 is reduced in cross-sectional area at one end to form a neck 12. Neck 12...will have sufficient pliability...to be deflected from its normal pendant position without adversely affecting the measure of control of the steering wheel movements afforded by the positive operating movement of the attachment, while at the same time, neck 12 will retain sufficient rigidity to permit operating movements of hand grip 11 to be positively communicated to the steering wheel rim for effective control of its movements. [Emphasis added]  
Anson, Page 1, Right Column, Line 49 – Page 2, Left Column, Line 18.

Of the claims of the present application, claim 14 is an independent claim and claims 15-19, 24/14 and 27/14 depend from claim 14. Claim 14, as amended, recites the following:

14. (Currently Amended) A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle, comprising:

a first section that connects to a peripheral portion of the steering wheel; and

a rigid, semi-rigid or flexible, or non-deformable second section that connects to, and extends from the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a front face of the steering wheel, the second section for providing resting support for at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for

deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. [Emphasis added.]

As shown about with regard to the invention of claim 14, the "second section" provides resting support for the vehicle operator's arm(s), wrist(s), etc. The second section providing "resting support" is supported in the present application and does not add new matter. For example, in Published Application No. US 2004/0255713 "resting support" is supported at least at Figure 3, and paragraphs [0013], [0028], and [0032].

The grip portion 11 of the Anson attachment described in the quotation from Anson is what the Examiner has equated to the "second section" of the claims of the present application. However, as is plainly seen the bulbular-formed grip portion 11 does not provide "resting support" for the driver's body; that is provided by the driver's lap. Noting this, Anson does not support a *prima facie* basis for anticipating claim 14; and Applicant has, therefore, traversed the anticipated rejection based on Anson.

Claims 15-19, 24/14, and 27/14 depend from claim 14. As such, each of these claims adds features to claim 14. Therefore, if claim 14 is not anticipated by Anson, claims 15-19, 24 and 27 that depend from claim 14 also are not anticipated by Anson for at least the same reasons as claim 14.

Applicant has traversed the anticipation rejection raised against claims 14-19, 24/14, and 27/14 based on Anson and request that it be withdrawn.

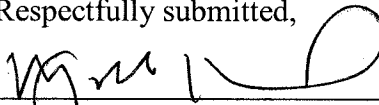
### **III. CONCLUSION**

Claims 14-19, 24/14, and 27/14 are pending in the present application. The Examiner's bases for rejecting these claims are under 35 U.S.C. §102 for anticipation based on Anson and a judicially created doctrine of obviousness-type double patenting. In the foregoing, Applicant has clearly traversed the Examiner's basis for rejecting amended claims 14-19, 24/14, and 27/14 for anticipation by Anson. Further, Applicant has stated he will file a terminal disclaimer upon the Examiner's allowance of the pending claims. Accordingly Applicant requests that the Examiner withdraw the anticipation rejection based on Anson.

The present invention is new, nonobvious, and useful. Reconsideration and allowance of the claims are respectfully requested and the application be passed to issue in due course.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-0219, under Order No.: 0114089.121US1 from which the undersigned is authorized to draw.

Respectfully submitted,



Dated: September 15, 2009

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Wayne M. Kennard  
Registration No. 30,271  
Attorney for Appellant

Wilmer Cutler Pickering Hale and Dorr LLP  
60 State Street  
Boston, MA 02109  
Tel: 617-526-6183  
Fax: 617-526-5000

## ATTACHMENT 1

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* DOUGLAS B. WILSON

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Appeal 2009-001868  
Application 10/727,306  
Technology Center 3600

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Decided: August 31, 2009

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Before LINDA E. HORNER, JOHN C. KERINS, and MICHAEL W.  
O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

### STATEMENT OF THE CASE

Douglas B. Wilson (Appellant) seeks our review under 35 U.S.C. § 134 of the final rejection of claims 14-19, 24, and 27. Claims 1-13 are canceled. Claims 20-23, 25, 26, and 28 are withdrawn. We have jurisdiction under 35 U.S.C. § 6(b) (2002). An oral hearing with Appellant's counsel occurred on August 13, 2009.

### THE INVENTION

The invention is to a hand and arm rest or support that prevents or lessens the amount of fatigue that occurs in the hand and arms from driving or steering a vehicle or vessel over an extended period.

Claim 14, reproduced below, is representative of the subject matter on appeal.

14. A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle, comprising:

a first section that connects to a peripheral portion of the steering wheel; and

a rigid, semi-rigid or flexible, or non-deformable<sup>1</sup> second section that connects to, and

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<sup>1</sup> At the oral hearing, Appellant's counsel referred to "non-deformable" as "deformable." When questioned, Appellant's counsel stated that the claims were amended during prosecution to replace "non-deformable" with "deformable." See Transcript of Oral Hearing conducted on August 13, 2009, page 5, line 10 to page 7, line 18. A review of the prosecution history does not reveal that the Office entered such an amendment. We will take Appellant's counsel's word at the hearing that the claim term "rigid, semi-rigid or flexible, or non-deformable" should be read as "rigid, semi-rigid or flexible, or deformable." Such a reading provides consistency with the other claim limitations. Further prosecution before the Examiner should include

extends from the first section at the peripheral portion of the steering wheel, the second section extends from the first section outward at an angle to a plane across a front face of the steering wheel, the second section for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel, and *deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.*

(App. Br. Claims Appendix) (emphasis added.)

#### THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Laubach	US 1,575,848	Mar. 9, 1926
Van Arsdell	US 2,118,540	May 24, 1938
Anson	US 2,134,020	Oct. 25, 1938

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an amendment to comport with Appellant's counsel's statements made during the oral hearing. Note that the term "non-deformable" appears throughout the Specification.



### THE REJECTIONS

The Examiner made the following final rejections:

A) Claims 14-19, 24, and 27 are rejected under 35 U.S.C. § 112, second paragraph.

B) Claims 14-17, 19/17, 24, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Van Arsdell.

C) Claims 14-17, 19/17, 24, and 27 are rejected under 35 U.S.C. § 102(b) as being anticipated by Anson.

D) Claims 14, 18, and 19/18 are rejected under 35 U.S.C. § 102(b) as being anticipated by Laubach.

E) Claims 14-19, 24, and 27 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 20-28 of copending patent Application No. 10/720,821.

### SUMMARY OF DECISION

We AFFIRM.

### ISSUES

1) Whether the Appellant has demonstrated error in the Examiner's provisional rejection of claims 14-19, 24, and 27 under the judicially created doctrine of obviousness-type double patenting over claims 20-28 of copending patent Application No. 10/720,821.

2) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-19, 24, and 27 under 35 U.S.C. § 112, second paragraph.

3) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27 as being anticipated by Van Arsdel. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because Van Arsdel explicitly discloses that the driver may remove and then reattach the grip rest in another location, this operation reads on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

4) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27 as being anticipated by Anson. This issue turns on whether the Appellant has shown that the Examiner erred in finding that Anson's explicit disclosure that the grip portion being made from a pliable and semi-rigid material permits this structure to read on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel, when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

5) Whether the Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18 as being anticipated by Laubach. This issue turns on whether the Appellant has shown that the Examiner erred in finding that, because a vehicle operator could unscrew Laubach's knobs and fasten the knobs to another position, this permits this structure to read on the capability of the claimed second section to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

#### FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

##### *Facts pertinent to the Provisional Obviousness-Type Double Patenting rejection*

1. The Notice of Appeal is silent as to the specific claims being appealed. See Notice of Appeal received Dec. 6, 2007.
2. The Appeal Brief clearly states that all of the finally rejected claims, claims 14-19, 24, and 27 are the subject of the appeal. App. Br. 1.

3. The Appeal Brief omits the provisional rejection under the judicially-created doctrine of obviousness-type double patenting in the grounds of rejection to be reviewed on appeal. App. Br. 6.
4. The Appeal Brief does not present arguments rebutting the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. App. Br., *passim*.
5. The Examiner maintains the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. Ans. 7-8.
6. In the Reply Brief, the Appellant recognizes that the Examiner maintains the provisional rejection under the judicially-created doctrine of obviousness-type double patenting, and the Appellant does not argue the Examiner erred in making the rejection. Reply Br. 1 and 2.

*Facts pertinent to the 35 U.S.C. § 112, second paragraph, rejection*

7. The Examiner reasons that the terms “rigid,” “semi-rigid,” “flexible,” and “non-deformable” are indefinite because the disclosure does not provide a standard to ascertain the requisite degree. Ans. 3-4.
8. Appellant provides, as evidence, excerpts from a standard dictionary to illustrate that these terms are common and have widely accepted meanings, and further, the Appellant states that he has not given any special meaning to these terms. App. Br. 8-9.
9. The Examiner responds to the Appellant’s evidence and argument by citing to *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc) and then states that *Phillips* stands for the proposition that the

Specification is the single best guide to determining the meaning of a claim term. As such, the Examiner posited that because the Specification does not provide guidance as to what type of materials are considered to be “rigid, semi-rigid, or flexible, or non-deformable” this makes these claim terms unclear and/or ambiguous. Ans. 9-10.

10. Appellant urges that *Phillips*, 415 F.3d at 1314, supports his position because dictionary definitions are appropriate evidence to show the widely accepted meaning of commonly understood words. Reply. Br. 5.

*Facts pertinent to the anticipation rejections*

11. The Appellant does not contest the Examiner’s finding that each of Van Arsdel, Anson, and Laubach discloses a first section that connects to a peripheral portion of a steering wheel. App. Br. and Reply Br., *passim*.
12. The Appellant does not contest the Examiner’s finding that each of Van Arsdel, Anson, and Laubach discloses a second section that connects to, and extends from, the first section. App. Br. and Reply Br., *passim*.
13. The Appellant does not contest the Examiner’s finding that Anson’s and Laubach’s second section is for supporting a portion of a vehicular operator’s body when pressure from the operator’s body portion is less than the pressure needed to deform the second section. App. Br. and Reply Br., *passim*. Van Arsdel’s objective is to provide

a second section (grip-rest 2)<sup>2</sup> to an automobile steering wheel which will support the thumb and fingers and keep the hand in a proper steering position (comfortable for his thumb and fingers and which will keep the hand in a proper steering position). (Van Arsdel, p. 1, left column, ll. 1-5). Additionally, Van Arsdel discloses that:

The weight of the hand and arm are comfortably supported with the bottom of the hand resting in the concavity of the grip-rest ... or with the ball of the thumb seated in the concavity as shown [in the figure] ... and the two optional positions afford opportunity for change which will keep the hand and arm from the cramp or strain from long driving.

(Van Arsdel, p. 1, right column, ll. 41-48). A device that has as its objective and is disclosed to comfortably support the hand and arm would not deform under the pressure that is needed to deform such a device. As such, we find that Van Arsdel explicitly discloses that its second section (grip-rest 2) is for supporting a portion of a vehicular operator's body when pressure from the operator's body portion is less than the pressure needed to deform the second section.

14. As such, we find that each of Van Arsdel, Anson, and Laubach, explicitly discloses:

A fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising: a first section that connects to a peripheral portion of the steering wheel; and a... second section that connects to, and extends from the first section at the peripheral portion of the steering wheel, ... the second section for

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<sup>2</sup> Parenthetical nomenclature, Van Arsdel.

supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel . . .

*See Claim 14, supra.*

*Van Arsdel*

15. The Examiner finds from Van Arsdel's disclosure (Van Arsdel, p. 1, right column, l. 49 to p. 2, left column, l. 2 and ll. 28-32) that the grip-rest 2 is adjustable. Lines 28-32 explain that loosening or reversing the screw 14 sufficiently permits the grip-rest 2 to shift position. From this disclosure, the Examiner finds that the grip-rest 2 could be placed at a position where it does not interfere with the operation of the steering wheel (*see* Ans. 11-12). As such, the Examiner finds that Van Arsdel's grip-rest 2 has the capability of deforming out of interference with the vehicular operator's body when the pressure from the vehicular operator's body is equal to or greater than the pressure needed to deform the second section out of interference. *Id.*
16. The Appellant argues that the portion of Van Arsdel's disclosure that the Examiner is using (Van Arsdel, p. 2, left column, ll. 28-32) to find that Van Arsdel's grip-rest 2 is deformable does not in fact support the Examiner's finding. Instead, this portion of Van Arsdel supports a finding that to move the grip-rest 2, the screw 14 must be loosened, the rest repositioned, and screw 14 tightened. The Appellant argues that this operation is not deforming according to claim 20 during

normal use of the second section (grip-rest) (parenthetical nomenclature to Van Arsdel). The Appellant argues, instead, that once positioned, the grip-rest is fixed. App. Br. 11.

17. The Appellant argues, further, that Van Arsdel's disclosure at p. 1, right column, ll. 22-28, reproduced below, supports the position that the grip-rest 2 of Van Arsdel does not deform according to claim 20 when pressure is applied to it:

These flanges 4 and 5 enable the operator instantly to feel any deviation of the car from a straight course and gives him something substantial to push against in resistance and also in rotating the wheel to steer the car around corners and curves and away from obstructions or bad places in the roadway.

App. Br. 11. *See also* Reply Br. 10.

*Anson*

18. The Examiner finds that Anson's grip portion 11 is constructed from a pliable and semi-rigid composition. *See* Ans. 5; Anson, p. 1, right column, ll. 5-24 and p. 2, right column, ll. 25-40. As such, the Examiner finds that Anson's steering wheel attachment is capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure applied is greater than or equal to the pressure needed to deform the attachment while the vehicular operator is operating the steering wheel. Ans. 6 and 12. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference.



19. The Appellant cites to Anson, p. 1, left column, ll. 6-25 and right column, l. 49 to p. 2, left column l. 18, to counter the Examiner's findings. App. Br. 12. Appellant then argues, based on the citation and quoted Anson passages:

[W]hen the Anson handgrip is in use, it is in the pendant position below the steering wheel and is used to steer the vehicle. If, during normal operations, the driver were to grab the steering wheel in an emergency situation, he would release the handgrip and grab the wheel, for example, at the 10 and 2 o'clock positions. In doing so, the pendant-hanging handgrip would not be deformed as set forth in claim 14 because it would not be in use at all.

App. Br. 13.

20. In responding to the Examiner's finding that movement of the steering wheel attachment provides further reason to find that the attachment is capable of deforming out of interference, the Appellant argues:

When the handgrip is moved to the top, it is moved there to be placed purposefully out of use all the time... If the handgrip is moved to the top of the steering wheel, as suggested by the Examiner, it would be awkward and dangerous to use for driving because the driver's hands would be disposed through the steering wheel.

App. Br. 14.

In this position, it also would not provide any of the benefits recited in Anson to relieve fatigue in the arms and hands of the driver.

App. Br. 13.

In order to move the handgrip, it would be understood that the vehicle would have to be stopped, the handgrip detached and repositioned at the top, and reattached.

App. Br. 14.

*Laubach*

21. The Examiner finds that portion 10 is capable of deforming out of interference because the driver can unscrew Laubach's knobs and move them to another position as desired by the driver. Ans. 14.
22. The Appellant argues that:

The description of the knobs and a review of the Figures makes plain that the knobs are not deformable and they are not disposed at an angle with respect to the plane across the face of the steering wheel. The knobs are rigidly connected to the steering wheel by screws 5. Any movement of them requires removing the screws, drilling the wheel at a new location, and reattaching the knobs at the new location. At this new location, the knobs will be in a plane parallel to the plane across the face of the steering wheel.

The knobs do not deform out of interference with the operation of the steering wheel as does the second section of claim 14. In fact, once the Laubach knobs are secured by screws 5 as shown and described, they are fixed and not movable during normal operations. If they are not unscrewed, the only movement would be to apply a destructive force to the knobs, thereby breaking them. Therefore, Laubach does not support a prima facie basis of anticipation because it is missing at least one element of claim 20 relating to deformation of the knobs out of interference with

the operation of the steering wheel in the normal operation of the knobs.

App. Br. 15.

#### PRINCIPLES OF LAW

Appellant has the burden on appeal to the Board to demonstrate error in the Examiner's position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (“[t]o reject claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness.... On appeal to the Board, an applicant can overcome a rejection [under § 103] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.”) (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

The test for definiteness under 35 U.S.C. § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986) (citations omitted).

A single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Thus, a prior art reference without express reference to a claim limitation may nonetheless anticipate by inherency. *See In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002).

“A patent applicant is free to recite features of an apparatus either structurally or functionally. See *In re Swinehart*, 439 F.2d 210, 212 (CCPA 1971) (“[T]here is nothing intrinsically wrong with [defining something by what it does rather than what it is] in drafting patent claims.”). Yet, choosing to define an element functionally, *i.e.*, by what it does, carries with it a risk.” *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997). As stated in *Swinehart*, 439 F.2d at 213:

... where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on.

## ANALYSIS

### *Issue (1)*

Appellant’s Notice of Appeal is silent as to the specific claims being appealed. Fact 1. The Appeal Brief clearly states that all of the finally rejected claims are the subject of the appeal. Fact 2. In the grounds of rejection under review, the Appeal Brief omits the provisional rejection under the judicially-created doctrine of obviousness-type double patenting. Fact 3. The Appeal Brief does not separately argue that ground of rejection. Fact 4. The Examiner maintains the provisional rejection. Fact 5. Appellant does not address the provisional rejection in the Reply Brief. Fact 6. As such, Appellant has not met his burden of demonstrating error in the Examiner’s position. See *Kahn*, 441 F.3d at 985-86. Therefore, with the

Examiner maintaining the rejection, the Notice of Appeal being silent as to specific claims being appealed, the Appeal Brief clearly stating that all finally rejected claims are the subject of the appeal, and no arguments made to demonstrate error in the Examiner's position within the Appeal Brief or Reply Brief, we summarily sustain the provisional obviousness-type double patenting rejection.

*Issue (2)*

As Appellant has pointed out, the claim term "rigid, semi-rigid or flexible, or non-deformable" is "readily apparent even to lay judges, and [this] claim construction ... involves little more than the application of the widely accepted meaning of commonly understood words." *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005). Appellant's use of the standard dictionary is not for construing the claim, but as evidence to demonstrate how a person of ordinary skill in the art would interpret this claim term when the claim term was read in light of the Specification. Facts 8 and 10. In this case, the claims recite all of the possible permutations of hardness of the second section. So, a person having ordinary skill in the art would be able to understand the scope of the claim, because it covers a second section of virtually any hardness. As such, we are constrained to not sustain this rejection.

*Issues (3), (4), and (5)*

Appellant does not separately argue the claims in each ground of rejection. *See App. Br. 9-16*. We select independent claim 14 as the representative claim for deciding whether the Appellant has demonstrated

error in the rejections set forth by the Examiner. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008). Accordingly, the dependent claims also rejected under each ground of rejection will stand or fall with claim 14 for each rejection.

We find that the prior art used by the Examiner explicitly discloses a fatigue relieving/preventing apparatus associated with a steering wheel for controlling a vehicle comprising a first section that connects to a peripheral portion of the steering wheel, and a second section that connects to, and extends from, the first section at the peripheral portion of the steering wheel, where the second section is for supporting at least a portion of a vehicular operator's body when pressure from the portion of the vehicular operator's body on the second section is less than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. *See* Facts 11-14.

The issue becomes whether the Appellant has shown error in the Examiner's finding that structures explicitly described in the prior art can satisfy the functional aspect of the second section being able to deform out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. Below we address whether the Appellant has shown error in the Examiner's rejection with respect to this issue for each piece of prior art.

*Anticipation with Van Arsdel*

We conclude that Appellant has met his burden in showing that Van Arsdel's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As the Appellant has stated, Van Arsdel's second section (grip rest) needs to be repositioned in order to be moved to a position out of interference with a driver's ability to steer the steering wheel (Fact 16), and parts of the second section (the flanges 4 and 5) give the driver something to push against to steer the car around corners and curves (Fact 17). A structure, as the Examiner has found (*see* Fact 15), that requires disassembly and reassembly, and permits the driver to push against it cannot reasonably be considered a structure that is capable of deforming out of interference as has been claimed. Accordingly, Appellant has met his burden in showing that Van Arsdel's structure is not capable of performing the deformation out of interference function claimed. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14-17, 19/17, 24, and 27.

*Anticipation with Anson*

We conclude that Appellant has not met his burden in showing that Anson's second section is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of

interference with the vehicular operator's ability to operate the steering wheel. The Examiner has clearly found that Anson prefers to use a pliable and semi-rigid composition to form the grip portion 11 that the Examiner is utilizing to read on the second structural aspect. *See* Fact 18. An article of manufacture made from a pliable and semi-rigid composition, *e.g.*, rubber, would inherently have a capability to deform out of interference. *See id.* The amount of deformation out of interference would be dependent upon the resilience property of the cured rubber and not its form. Appellant tries to show that Anson does not inherently possess the characteristic of deforming out of interference because the grip would either not be used in operation (Fact 19), would be dangerous to operate, or would not achieve the recited benefits (Fact 20). Neither argument outweighs the explicit disclosure that Anson's device is manufactured from a material that is pliable and semi-rigid and thus would have an inherent property of being deformable.

In this case, the Examiner has good reason (Fact 18) to believe that the functional limitation (deforming out of interference) asserted to be critical in establishing novelty in the claimed subject matter, is, in fact, an inherent characteristic of Anson's steering attachment. In such a case, the Appellant must provide evidence that Anson's steering attachment is not capable of deforming out of interference. *See Swinehart*, 439 F.2d at 213. Arguments that focus on a particular envisioned use of a device in a particular driving condition is not evidence that the device is not inherently capable of deforming out of interference. As such, Appellant has not met his burden of showing that Anson's steering attachment is not capable of



deforming out of interference as set forth in claim 14. Claims 15-17, 19/17, 24, and 27 fall with claim 14.

*Anticipation with Laubach*

We conclude that Appellant has met his burden in showing that Laubach's second section does not inherently possess the characteristic of being capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel. As Appellant argues, in the manner in which the Examiner has utilized Laubach in order to reach the deforming out of interference function, the knobs need to be disassembled and reassembled in order to be repositioned. *See* Facts 21 and 22. We agree with Appellant that the disassembly and reassembly of the knobs demonstrates that the knobs are fixed and the only manner of movement to the knobs, short of disassembly, would be destructive in nature to Laubach's device. As such, to find that the functional limitation of the second section deforming out of interference, as set forth in claim 14, is inherently satisfied on a manner of movement that either requires disassembly and reassembly or is destructive is unreasonable. Accordingly, the Appellant has met his burden in showing that Laubach does not possess the capability of deforming as set forth in claims. Thus, Appellant has demonstrated error in the Examiner's rejection of claims 14, 18, and 19/18.

### CONCLUSIONS

Appellant has not met his burden of demonstrating error in the Examiner's position rejecting the appealed claims under the judicially created doctrine of obviousness-type double patenting.

Appellant has met his burden of demonstrating error in the Examiner's conclusion that the appealed claims are indefinite.

Appellant has met his burden of showing that the structures in Van Arsdel and Laubach are not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second section is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

Appellant has not met his burden of showing that the steering wheel attachment disclosed in Anson is not capable of deforming out of interference with the vehicular operator's ability to operate the steering wheel when the pressure from the portion of the vehicular operator's body on the second is equal to or greater than the pressure for deforming the second section out of interference with the vehicular operator's ability to operate the steering wheel.

### DECISION

The Examiner's decision to provisionally reject claims 14-19, 24, and 27 under the judicially-created doctrine of obviousness-type double

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patenting as being unpatentable over claims 20-28 of copending patent Application No. 10/720,821 is summarily affirmed.

The Examiner's decision to reject claims 14-19, 24, and 27 under 35 U.S.C. § 112, second paragraph, is reversed.

The Examiner's decision to reject claims 14-17, 19/17, 24, and 27 as being anticipated by Van Arsdell is reversed.

The Examiner's decision to reject claims 14-17, 19/17, 24, and 27 as being anticipated by Anson is affirmed.

The Examiner's decision to reject claims 14, 18, and 19/18 as being anticipated by Laubach is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

mls

WILMERHALE/BOSTON  
60 STATE STREET  
BOSTON, MA 02109